

REMARKS

A. BACKGROUND

The present Amendment is in response to the Office Action mailed November 14, 2008. Claims 1-20 were pending, claims 19 and 20 were previously withdrawn, and claims 1-18 rejected in view of cited art.¹ Claims 1-18 remain pending in view of the above amendments.

Reconsideration of the application is respectfully requested in view of the following remarks. For the Examiner's convenience and reference, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

Please note that the following remarks are not intended to be an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed below are presented solely by way of example to illustrate some of the differences between the claimed invention and the cited references. In addition, Applicant requests that the Examiner carefully review any references discussed below to ensure that Applicant's understanding and discussion of the references, if any, is consistent with the Examiner's understanding.

B. EXAMINER'S INTERVIEW

Applicant and Applicant's representative express appreciation to the Examiner for conducting a telephone interview to discuss the status of the previously filed amendment as relates to the newly received Office Action. The substance of the interview is included in this response.

C. OBJECTION OF AMENDMENT AND REJECTION UNDER 35 U.S.C. § 112, FIRST PARAGRAPH

The Office action objected to the "amendment filed 7/25/08 . . . under 35 USC 132(a) because it introduces new matter into the disclosure. . . . The added material which is not supported by the original disclosure is as follows: a 'method of trimming' instead of a 'method of coupling a stent to a balloon'" (Office Action, page 2). The pending claims were "rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description

¹ Although the prior art status of the cited art is not being challenged at this time, Applicant reserves the right to challenge the prior art status of the cited art at any appropriate time, should the need arise. Accordingly, any arguments and amendments made herein should not be construed as acquiescing to any prior art status of the cited art.

requirement. . . . The original claims and disclosure were directed to a method of coupling a stent, not a method of trimming" (Office Action, page 2). Applicant respectfully traverses because the claims as originally filed were directed to a "method of trimming" rather than a "method of coupling a stent".

The claims 1-18 as originally filed were directed to a "method of trimming a balloon of a balloon catheter", while claims 19-20 as originally filed were directed to a "balloon catheter." Through the response filed May 2, 2007, in response to the Restriction Requirement of April 6, 2007, claims 1-18 were elected.

The Office Action of August 30, 2007 objected to the title of the invention and rejected the claims because "[t]he preambles to the claims are drawn to a method of trimming, yet there are no trimming steps in the specification or the claims" (Office Action of August 30, 2007, pages 2 and 3). The response of 24 January 2008 amended the claims and specification to a method of coupling a stent to a balloon, which resulted in notification that the prior Office Action response was not fully responsive. In reply to this notice of April 7, 2008, and but for the correction of grammatical errors, the response of July 25, 2008 returned the specification and claims to the form as originally filed, while responding to the objection to the specification, the rejection to the claims, and the prior art rejections under 35 USC 103.

Applicant respectfully requests reconsideration of the claims as originally filed in view of the response of July 25, 2008 and respectfully requests withdrawal of the current objection and rejection because the claims as originally filed were a "method of trimming" and not a "method of coupling" as is currently suggested.

D. CONCLUSION

In view of the foregoing, Applicant respectfully submits that the other rejections to the claims are now moot and do not, therefore, need to be addressed individually at this time. It will be appreciated, however, that this should not be construed as Applicant acquiescing to any of the purported teachings or assertions made in the last action regarding the cited art or the pending application, including any official notice. Instead, Applicant reserves the right to challenge any of the purported teachings or assertions made in the last action at any appropriate time in the future, should the need arise. Furthermore, to the extent that the Examiner has relied on any Official Notice, explicitly or implicitly, Applicant specifically requests that the Examiner

provide references supporting the teachings officially noticed, as well as provide the required motivation or suggestion to combine references with the other art of record.

For at least the foregoing reasons, Applicant respectfully submits that the pending claims are neither anticipated by nor made obvious by the art of record. In the event that the Examiner finds any remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney.

Dated this 16th day of March, 2009.

Respectfully submitted,

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